

### REMARKS

The Official Action dated January 13, 2003 has been carefully considered. Accordingly, the changes presented herewith, taken with the following remarks, are believed sufficient to place the present application in condition for allowance. Reconsideration is respectfully requested.

Claims 18-20 have been cancelled and rewritten as claims 24-26 incorporating all claims dependent thereon. Attached hereto is "**Version With Markings To Show Changes Made**" showing the changes made to the claims with the current amendment. Since these changes do not involve any introduction of new matter, entry is believed to be in order and is respectfully requested.

In the Official Action, claims 1, 2 and 6-12 were rejected under 35 U.S.C. §102(e) as being anticipated by Ozawa et al. (U.S. Patent No. 6,445,461). The Examiner asserted that Ozawa et al. teach a photoprinter configuration comprising: a digital camera comprising a viewable display and one or more selection mechanisms; and a photoprinter capable of processing and printing digital files independent of an external host device and connected to the digital camera via communication link, the photoprinter being operative to control the viewable display of the digital camera. However, as will be set forth in detail below, it is submitted that the photoprinter configurations and methods for controlling a digital camera defined by claims 1, 2 and 6-12 are not anticipated by Ozawa et al. Accordingly, this rejection is traversed and reconsideration is respectfully requested.

As defined by claim 1, the present invention is directed to a photoprinter configuration. The configuration comprises: a digital camera comprising a viewable display and one or more selection mechanisms; and a photoprinter capable of processing and printing digital files independent of an external host device and connected to the digital camera via a communication link, the photoprinter being operative to control the viewable display of the

digital camera, wherein processing the digital files comprises calculating a pixel pattern to be printed on a printable medium.

As defined by claim 7, the present invention is directed toward a method for controlling a digital camera. The method comprises the steps of: obtaining a photoprinter capable of processing and printing digital files independent of an external host device and operable to print digital photographs onto printable media, wherein processing the digital files comprises calculating a pixel pattern to be printed on the printable media; obtaining a digital camera comprising a viewable display and one or more selection mechanisms; connecting the digital camera to the photoprinter via a communication link; transmitting a plurality of instructions from the photoprinter to the digital camera via the communication link; and controlling the digital camera by the photoprinter in accordance with the plurality of instructions.

As further clarified by the present Amendment, “processing digital files” comprises calculating a pixel pattern to be printed on the printable media (e.g., ripping or generating print code). For example, as noted in the present specification on page 3, lines 17-28 “a printer is considered standalone if an external device **merely passes a digital photograph** to the printer and the printer **contains the logic for processing** and printing the digital photograph.” (emphasis added)

Ozawa et al. disclose an image processing system comprising a digital camera and a printing apparatus. While described in terms of multiple embodiments, the embodiments of Ozawa et al. appear to take two basic forms. In one form, the digital camera executes print data conversion software to convert image data into a data format that the printer can print (i.e., print data). In the second form, the print data conversion software is executed on the printer to convert image data from the camera into print data that can be printed.

With respect to the first form, the print data conversion software can be preinstalled on the camera or transmitted to it from a printer or a computer upon request by the camera (or the computer). The print data conversion software apparently also includes programs associated with various kinds of mode setting and a user interface for setting a mode upon printing print data. After converting the image data to print data, the camera then transmits the print data to the printer. Meanwhile, with respect to the second form, instead of requesting that the printer transmit the print data conversion software to it, as discussed above, when an image is to be printed by the printer, the camera (or a computer) transmits the print data conversion software to the printer (or the printer executes such software which is preinstalled on the printer).

Apparently with reference to the first form, the Examiner appears to rely on the transmission of the print data conversion software by the printer to the digital camera for teaching the limitation that the photoprinter is operative to control a viewable display of the camera (claim 1) and the limitation that the digital camera is controlled by the photoprinter in accordance with a plurality of instructions transmitted from the photoprinter (claim 7). However, when Ozawa et al. discusses transmitting software to a camera, it appears to do so exclusively in the context of a system of the first form, which by definition does not include a printer capable of processing and printing digital files independent of an external host device. In fact, it appears that, in this first form of the system of Ozawa et al., the transmission of the print data conversion software to the camera is at least primarily directed at allowing the camera (not the printer) to process digital files.

Simply stated, the printer of the first form of Ozawa et al. lacks the ability to process digital files independent of an external host device, and the first form appears to be specifically focused on what can be done in a system that includes such a printer (as opposed to one that can process digital files independent of an external host device). As such, it does

not disclose or teach a photoprinter (that is capable of processing digital files independent of an external host device) operative to control a viewable display of the camera (claim 1) or a controlling a digital camera by a photoprinter (that is capable of processing digital files independent of an external host device) in accordance with a plurality of instructions transmitted from the photoprinter (claim 7).

Furthermore, the second form of the system of Ozawa et al. also fails to disclose or teach the present inventions as set forth in claims 1 and 7. For example, with respect to this second form, Applicants find no teaching or disclosure of a photoprinter being operative to control the viewable display of the digital camera (claim 1) or controlling a digital camera by a photoprinter in accordance with a plurality of instructions transmitted from the photoprinter (claim 7). More particularly, in the form of the system of Ozawa et al. that does includes a printer that can convert image data into print data, it does not appear that any print data conversion software (or the like) is transmitted from the printer to the camera. As such, in those embodiments where it teaches using a printer that arguably can process digital files, Ozawa et al. does not teach making that printer operative to control a viewable display of the camera or controlling a digital camera by that printer. Accordingly, Applicants find no teaching or disclosure in Ozawa et al. of a photoprinter being operative to control the viewable display of the digital camera, as required by claim 1, or controlling a digital camera by a photoprinter in accordance with a plurality of instructions transmitted from the photoprinter, as required by claim 7.

Anticipation under 35 U.S.C. §102 requires the disclosure in a single prior art reference of each element of the claims under consideration, *Alco Standard Corp. v. TVA*, 808 F.2d 1490, 1 U.S.P.Q.2d 1337, 1341 (Fed. Cir. 1986). As Applicants find no teaching by Ozawa et al. relating to a photoprinter, capable of processing digital files independent of an external host device, operative to control a viewable display of a camera (claim 1) or

controlling a digital camera by a photoprinter, capable of processing digital files independent of an external host device, in accordance with a plurality of instructions transmitted from the photoprinter (claim 7), Ozawa et al. fails to anticipate claims 1 and 7, or any of the claims that depend therefrom (e.g., claims 2 and 6, and 8-12, respectively) under 35 U.S.C. §102. It is therefore submitted that the presently claimed printer configurations and methods are not anticipated by Ozawa et al., whereby the rejection under 35 U.S.C. §102(e) has been overcome. Reconsideration is respectfully requested.

Furthermore, it would be improper to use Applicants' present invention as a roadmap to pick and choose those aspects of the first form and second form of Ozawa et al. and combine them in such a manner to arguably arrive at the presently claimed inventions. For example, modifying the first form in such a way that its printer would also be capable of processing digital files independent of an external host would appear to obviate the central premise of that form of its system (i.e., transmitting print data conversion software to a camera to allow it to perform the conversion). Meanwhile, with respect to the second form in the system of Ozawa et al., since its camera appears to be the requesting device, there is simply no motivation to make the printer operative to control the camera. In fact, if anything, in this context, the system of Ozawa et al. appears to teach away from this modification (e.g., it appears to teach a system in which the camera is the device that controls the printer).

Claims 13-23 were rejected under 35 U.S.C. §103 as being unpatentable over Ozawa et al. in view of Taniguchi et al. (U.S. Patent No. 5,999,707). The Examiner noted that Ozawa et al. fail to teach the photoprinter as a passthrough device such that the host computer may initiate requests to the peripheral. The Examiner asserts that Taniguchi et al. teach that it is well-known in the art to make a printer operate as a client to a host computer. The Examiner asserted that therefore it would have been obvious to have one of ordinary skill in

the art at the time the invention was made to provide the infrared communication as taught by Ozawa et al. with the means to allow the printer to operate as a host to the printer.

However, as will be set forth in detail below, it is submitted that the printer configurations of claims 13-23 are non-obvious and patentably distinguishable from the teachings of Ozawa et al. in further view of Taniguchi et al. Accordingly, this rejection is traversed and reconsideration is respectfully requested.

As defined by claim 13, the present invention is directed to a printer configuration. The configuration comprises a host computer; a peripheral device; and a stand-alone printer connected via a communication link to the host computer and the peripheral device, wherein the stand-alone printer is operable as a client to the host computer, as a host for the peripheral device, and as a pass-through device such that the host may initiate requests to the peripheral device; wherein the stand-alone printer is capable of processing and printing digital files independent of the host computer, and further wherein processing the digital files comprises calculating a pixel pattern to be printed on a printable medium.

As defined by claim 21, the present invention is directed to a printer configuration. The configuration comprises a universal serial bus; a stand-alone printer connected to the universal serial bus as a universal serial bus host; and a peripheral device connected to the universal serial bus as a universal serial bus device, said peripheral device being subordinate to the stand-alone printer; wherein the stand-alone printer is capable of processing and printing digital files independent of an external host device, and further wherein processing the digital files comprises calculating a pixel pattern to be printed on a printable medium.

With respect to claim 13, the Examiner admits that Ozawa et al. fails to teach a stand-alone printer that is operable as a passthrough device such that a host computer may initiate requests to the peripheral device. The Examiner attempts to accommodate for that failure by referencing Taniguchi et al. However, the Examiner only asserts that Taniguchi et al. teaches

that it is well-known in the art to make a printer operate as a client to the host computer. There is no proposition even made that Taniguchi et al. teaches anything with respect to a passthrough device.

References relied upon to support a rejection under 35 U.S.C. §103 must provide an enabling disclosure, i.e., they must place the claimed invention in the possession of the public. *In re Payne*, 203 U.S.P.Q. 245 (C.C.P.A. 1979). Furthermore, to establish prima facie obviousness of the claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). As neither Ozawa et al. or Taniguchi et al., alone or in combination, teach, disclose or suggest, *inter alia*, a stand-alone printer that is operable as a passthrough device, the purported combination of Ozawa et al. and Taniguchi et al. does not support a rejection of claim 13 (or the claims dependent thereon, claims 14-17) under 35 U.S.C. §103. Reconsideration is respectfully requested.

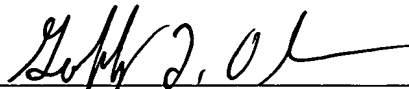
Meanwhile, in attempting to reject claim 21 (and claims 22-23, which are dependent thereon), the Examiner merely suggests that the limitations "are covered by the limitations of claims 13-17 above." Applicants respectfully disagree. For example, claim 21 requires a peripheral device, connected to a universal serial bus as a universal serial bus device, which is subordinate to a stand-alone printer. The purported rejections of claims 13-17 do not appear to address anything with respect to, *inter alia*, subordination of a peripheral device with respect to a printer.

It is therefore submitted that the presently claimed printer configurations are non-obvious over and patentably distinguishable from Ozawa et al. in view of Taniguchi et al., whereby the rejection under 35 U.S.C. §103 has been overcome. Reconsideration is respectfully requested.

Finally, Applicants appreciate the Examiner's indication of the allowable subject matter of claims 18-20. Newly added claims 24-26 incorporate the limitations of claims 18-20, as well as independent claim 13 and any intervening claim. Therefore it is believed that claims 24-26 are prima facie allowable.

It is believed that the above represents a complete response to the Examiner's rejections under 35 U.S.C. §§102 and 103 and places the present the application in condition for allowance. Reconsideration and an early allowance are requested.

Respectfully submitted,



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**VERSION WITH MARKINGS SHOWING CHANGES MADE**

**In the Claims:**

Please cancel claims 18-20.

Please amend claims 1, 7, 13 and 21 as follows:

--1. (Twice Amended) A photoprinter configuration, comprising:

- a) a digital camera comprising a viewable display and one or more selection mechanisms; and
- b) a photoprinter capable of processing and printing digital files independent of an external host device and connected to the digital camera via a communication link, the photoprinter being operative to control the viewable display of the digital camera[.];  
wherein processing the digital files comprises calculating a pixel pattern to be printed on a printable medium.--

--7. (Twice Amended) A method for controlling a digital camera, comprising the steps of:

- a) obtaining a photoprinter capable of processing and printing digital files independent of an external host device and operative to print digital photographs onto printable media[.], wherein processing the digital files comprises calculating a pixel pattern to be printed on the printable media;
- b) obtaining a digital camera comprising a viewable display and one or more selection mechanisms;
- c) connecting the digital camera to the photoprinter via a communication link;
- d) transmitting a plurality of instructions from the photoprinter to the digital camera via the communication link; and
- e) controlling the digital camera by the photoprinter in accordance with the plurality of instructions.--

--13. (Amended) A printer configuration, comprising:

- a) a host computer;
- b) a peripheral device; and
- c) a stand-alone printer connected via a communication link to the host computer

and the peripheral device, wherein the stand-alone printer is operable as a client to the host computer, as a host for the peripheral device, and as a pass through device such that the host computer may initiate requests to the peripheral device[.];

wherein the stand-alone printer is capable of processing and printing digital files independent of the host computer, and further wherein processing the digital files comprises calculating a pixel pattern to be printed on a printable medium.--

--21. (Amended) A printer configuration, comprising:

- a) a universal serial bus;
- b) a stand-alone printer connected to the universal serial bus as a universal serial bus host; and
- c) a peripheral device connected to the universal serial bus as a universal serial bus device, said peripheral device being subordinate to the stand-alone printer[.];

wherein the stand-alone printer is capable of processing and printing digital files independent of an external host device, and further wherein processing the digital files comprises calculating a pixel pattern to be printed on a printable medium.--